

REMARKS

Claims 1-39 are pending in the application. Claims 40-61 are withdrawn. In this response, claims 1 and 3 are amended and claim 2 is canceled. No new matter is believed to be added by this amendment. Applicant submits that all of the claims are now in a form for allowance.

Claim Rejections – 35 U.S.C. § 102

In the Office Action, claims 1-39 were rejected under 35 U.S.C. 102(e) as being anticipated by Hartman et al. (US Patent 5,960,411) (“Hartman”). Specifically, in regard to claim 1, the Office Action provides that:

“Hartman teaches a method in a media service system for transaction configuration, the method comprising the steps of: enabling at least one selection by a user of at least one transaction configuration option (col. 5, lines 9-26; col. 6, lines 39-63); and implementing at least one transaction process responsive to the selection of the at least one transaction configuration option (col. 7, lines 4-23). ... to enable a subscriber to initiate and complete and entire *purchase* in one execution (col. 4, lines 31-38) . . .” (Emphasis added.)

Specifically, Hartman teaches a Web-based “method and system for single-action *ordering* of items in a client/server environment.” (Col. 3, lines 31-33, emphasis in italics added.) Hartman teaches ordering through a television based system, “[a] client system may comprise any combination of hardware or software that can interact with the server system. These systems may include television-based systems or various other consumer products through which *orders may be placed*.” (Col. 6, lines 33-38, emphasis added in italics.) However, Hartman fails to disclose ordering media content for purchase over a media service system and providing media content over the media service system to at least one client device, wherein the at least one transaction configuration option is a single execution option, and delivery of the purchased media content is provided through the media service system, as is claimed in amended claim 1.

A proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). The test is the same for a process.

Anticipation requires identity between the claimed process and a process of the prior art. The claimed process, including each step thereof, must have been described or embodied, either expressly or inherently, in a single reference. *See, e.g., Glaverbel S.A. v. Northlake Mkt'g & Supp., Inc.*, 45 F.3d 1550, 33 USPQ2d 1496 (Fed. Cir. 1995). Those elements must either be inherent or disclosed expressly. *See, e.g., Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991). In summary, the single prior art reference must properly disclose, teach or suggest each element of the claimed invention. Moreover, "every element of the claimed invention must be literally present, arranged as in the claim. ... The identical invention must be shown in as complete detail as is contained in the patent claim." *See, e.g., Richardson v. Suzuki Motor Company Co.* 868 F.2d 1226, 1236 (Fed. Cir. 1989).

As provided above, a claim can be anticipated only if each and every limitation of that claim is found in a single prior art reference. As Hartman does not teach or disclose a method for ordering media content for purchase over a media service system and providing purchased media content over an STS transmission system to at least one client device, wherein the at least one transaction configuration option is a single execution option, and delivery of the purchased media content occurs through the media service system, as found in independent claim 1 of the present application. As such, Applicant respectfully submit that claim 1 is not anticipated by Hartman, and is in a form for allowance. Similarly, as claims 2-39 depend either directly or indirectly from allowable independent claim 1, Applicant submits that these claims are also in a form for allowance. *See In re Fine*, 5 U.S.P.Q.2d 1569, 1600 (Fed. Cir. 1988) ("Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious."). Using this same rationale, dependent claims cannot be anticipated if the independent claims from which they depend are not anticipated.

Conclusion

Claims 1-39 are currently pending in the patent application. Of these pending claims, claim 1 is an independent claim. Since the Applicants respectfully assert that this independent claim is allowable, dependent claims 2-39 are also allowable. Thus, Applicants respectfully request allowance of all the pending claims in view of the subsequent remarks regarding the above-mentioned independent claims.

No fee is believed due; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

NEEDLE & ROSENBERG, P.C.

//David A. Cornett//
David A. Cornett
Registration No. 48,417

Customer No. 23859
(678) 420-9300 (phone)
(678) 420-9301 (fax)